

both independent claims and claims that depend from such independent claims, are novel and unobvious over the prior art of record, which does not teach, disclose, suggest, or otherwise motivate those skilled in the art to combine elements from the prior art references. This is more apparent in light of Applicant's arguments as described hereinbelow.

5

1.1 Claims 1 to 24 Are Rejected as Being Unpatentable Over Hartman '526 in view of Jenkins et al. '288 & Slasinski '912

Applicant's independent claims 1, 8, and 16 are directed to the new and inventive configurations as set forth therein, as well as to the additional features and elements set forth in each dependent claim that incorporates each and every element in the respective independent claims. In independent claim 1, applicant describes:

1. A flashing strip assembly, comprising:
a plurality of flashing sections formed from a metallic sheet material to have a generally V-shaped configuration and opposite edge portions, each section being further formed with at least one attachment hole and at least one alignment indicium wherein each section of the plurality is adapted to be arranged to overlap with another section of the plurality about the edge portions; and
at least two clinch joints formed in the edge portions of at least two of the flashing sections wherein the clinch joints are substantially registered on the overlapping edge portions and are thereby operative to releasably fasten the sections together. (*Emphasis added by applicant for purposes of illustrating arguments below*)

In independent claim 8, applicant depicts:

8. A flashing strip assembly, comprising:
a plurality of flashing sections formed from a metallic sheet material to have opposite edge portions arranged about a generally V-shaped configuration,

wherein each section of the plurality is adapted to be arranged to overlap with another section of the plurality about respective edge portions; and

at least two clinch joints formed in the edge portions of at least two of the flashing sections wherein the clinch joints are substantially registered on the overlapping edge portions and are thereby operative to releasably fasten the sections together. (*Emphasis added by applicant for purposes of illustrating arguments below*)

In independent claim 16, applicant discloses:

16. A flashing assembly, comprising:
a plurality of overlapping flashing sections each formed from a sheet material to have opposite edge portions arranged about a generally V-shaped configuration; and
at least one clinch joint substantially formed and registered upon overlapping edge portions of at least two of the plurality of overlapping flashing sections and adapted to releasably fasten the at least two sections together.

In contrast to applicant's claimed inventive flashing strips and assemblies, the references of record, including the specifically cited Hartman, Slasinski, and Jenkins et al. references are limited to loosely arranged flashing sections that are permanently and or ineffectively joined together in a way to does not operate or function as applicant's claimed invention. Additionally, the specifically cited patents as well as the other known references do not establish or even suggest the markedly improved capabilities of applicant's invention.

In further contrast, Hartman '526 is limited to, among other limitations, a step flashing strip that in every embodiment incorporates spacers **34, 34a, 162** that operate to establish an undesirable interstice to create "a gap or space **40**" (see, col. 3, line 1), which is intended to permit the user to install a roofing shingle there between (see col. 3, ll. 1-4). This difference teaches away from applicant's tightly joined flashing sections which are designed to eliminate

accumulation of moisture and debris that can create very undesirable long-term deterioration of the building roofing structure.

The other references of record here, including the cited Slasinski '912 reference and the Jenkins et al. '288 reference do not offer, disclose, suggest, or describe anything that motivates or directs the reader of the Hartman '526 reference to reach applicant's claimed invention.

Moreover, the Slasinski '912 patent is restricted to a permanent clinch joint that incorporates, among equally undesirable limitations, a deformed mushroomed upper region (see FIGS. 9 & 10) that cannot be released without destruction of the proximate area on the joined sheets. The Jenkins et al. '288 is similarly deficient of any suggestions or motivations that might point

someone having ordinary skill in the art to arrive at applicant's new and novel invention as claimed. Instead, Jenkins et al. '288 is limited to, among other restrictions, a roofing shingle that incorporates alignment indicia (see FIG. 1) for use in shingle-to-shingle alignment during installation. Here again, like Slasinski '912, Jenkins '288 teaches away from applicant's inventive alignment indicia that are configured to function as shingle-to-flashing alignment guides; this is a capability utterly absent from any of the references of record, including those specifically noted herein and cited by the examiner.

Among many other distinguishing features and capabilities, applicant notes that the invention as claimed in independent claims 1, 8, and 16 particularly contemplates the generally V-shaped configuration in combination with the tight but releasable clinch joints that together establish a firmly joined strip of flashing sections that not only reduce the fastener requirements of the installer or user, but which also creates a moisture and debris resistant arrangement that does not need the ineffective and limited adhesives and sealants that must be used in the prior art flashing devices.

Even if the specifically cited and other references of record offered some actual or perceivable suggestion or motivation to combine all of the elements of all of the references of record, applicant maintains that the inventive flashing strips and assemblies would remain unavailable to the skilled artisan; applicant's invention would instead remain new and novel and
5 utterly absent from the minds of those having ordinary skill in the art.

In characterizing each of the cited references, the examiner has not cited any disclosure in the asserted references that establishes a description, suggestion, motivation, or incentive that would drive one with ordinary skill in the art to combine the references or to think of the claimed capabilities and functions of applicant's claimed invention. Applicant requests that the examiner
10 provide any evidence that bears on the materiality and accuracy of the asserted motivation, suggestion, or incentive to combine.

In contrast, applicant contends that none of the cited references offer any suggestion or motivation to combine for purposes of achieving applicant's invention as claimed in each independent claim 1, 8, and 16, as well as the dependent claims therefrom. Particularly telling is
15 that even if there were some disclosure, recommendation, or reason in either reference to combine, no combination of the asserted or other references of record would function for applicant's intended and claimed purpose: tightly but releasably joined strips and assemblies. As noted, the asserted Hartman, Slasinski, and Jenkins et al. devices can not be adapted to establish applicant's tightly joined, releasable strips and assemblies.

20 Conversely, the asserted Hartman '526 device could not function as Hartman intended if it were modified to eliminate the spaces or gaps. Similarly, the Slasinski '912 joint, if modified to be releasable, would not give the permanent joint he contemplates. And, the Jenkins et al.

'288 indicia can not be modified to enable an installer of applicant's flashing strips and assemblies to align rows of shingles after installation of applicant's novel flashing devices.

Even with applicant's claimed invention as a road map, one having ordinary skill in the art would not, without hindsight, be motivated to combine any or all of the references of record here because none of the references contain the new and novel features and elements of applicant's invention as claimed and even if they did, the asserted and other references do not offer any suggestion or motivation to combine. Moreover, one with ordinary skill would not be motivated, after reviewing all of the references, to modify any conceivable combination to have the heretofore unknown configurations and improvements of applicant's invention as claimed.

Even further, assuming that each of applicant's claimed features, components, and elements could be found in a combination of the references of record here, the law is well settled: the test for obviousness under §103 mandates that the references, taken as a whole, must suggest the invention to one of ordinary skill in the art. Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 220 U.S.P.Q. (BNA) 97 (Fed. Cir. 1983). A retrospective view of inherency is not a substitute for some actual, explicit teaching or suggestion that supports the selection and use of the various elements in the particular asserted combination. That which is inherent is not necessarily known. Obviousness cannot be predicated on what is unknown. In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q.2d (BNA) 1955 (Fed. Cir. 1993); In re Newell, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). Even if we could assume that the applicant's invention could be found piecemeal among the references of record here, it is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. Bausch & Lomb, Inc. v.

Barnes-Hind, Inc., 796 F.2d 443, 230 U.S.P.Q. (BNA) 416 (Fed. Cir. 1986); In re Hedges, 783 F.2d 1038, 228 U.S.P.Q. (BNA) 685 (Fed. Cir. 1986).

In light of applicant's claims and the clear legal precedent, even if the examiner was not using Applicant's claimed invention as a road map for purposes of picking and choosing the required elements from the prior art, the asserted combinations in this application would be improper because none of the references in any combination describe all of applicant's claimed components.

Accordingly, since the asserted and cited references of record do not describe each element as claimed, and since the record references do not point to any reason to combine, the §103(a) obviousness rejection is improper and should be withdrawn.

Equally important, in addition to teaching away from applicant's invention, none of the record references are directed to addressing the problems solved by Applicant's claimed invention, which include, among others, releasability and tightly-joined moisture and debris resistant flashing strips and assemblies that will reduce the work and number of fasteners needed for installation while simultaneously establishing the moisture and debris barrier without the need for application of post-installation sealants. Even if all of the record references could be combined, and even if that combination could establish each element of applicant's invention as claimed in the independent and dependent claims, that which may be inherent, especially in hindsight, is not necessarily known. See, e.g., In Re Rijckaert. Applicant would gratefully review any evidence that examiner believes bears on the materiality and accuracy of this assertion.

CONCLUSION

Entry of the above amendments to the specification and arguments is requested. It is believed that claims 1 through 24 as originally filed distinguish over the prior art of record in this case and that the amendments described hereinabove do not constitute new matter because all such information was previously disclosed in the specification, drawings, and claims of this application. Accordingly, withdrawal of the examiner's rejections and an early allowance of the currently pending claims are respectfully solicited.

Applicant's representative hereby also further requests a telephonic or in-person formal interview as soon as possible to discuss the preceding amendments and arguments for purposes of expediting further action in this application. In addition to formal filing of Applicant's response, a courtesy copy of this amendment will be sent by facsimile directly to the examiner for early consideration of the merits of Applicant's amendments and arguments in support of patentability.

Any fee underpayment may be deducted from and overpayment may be refunded to Deposit Account No. 50-1526 in the name of Sean M. Casey Co., L.P.A. The under-signed attorney may be contacted anytime at (614) 222-0800 if any further information is required. Please stamp the enclosed, preaddressed, postage-paid, return-receipt postcard and return it to me. Thank you for your attention to this matter.

Respectfully submitted,

JERRY JOSEPH QUINN

By: SEAN M. CASEY CO., L.P.A.

Sean M. Casey

Registration No. 39,514

Telephone: (614) 222-0800

APPENDIX A - SUMMARY OF APPLICANT'S AMENDMENTS

IN THE SPECIFICATION

5 At page 10, line 17, please replace "securing" is replaced with --securely--.

At page 11, line 3, before "otherwise", Applicant inserted --as--.

At page 11, line 3, before "without", Applicant inserted --and even--.